

REMARKS/ARGUMENTS

Claims 1-22 remain in the application, and reconsideration of this application is respectfully requested in view of the following remarks and arguments.

Applicants first acknowledge that the Examiner has allowed claims 12-20. Applicants further acknowledge that the Examiner has objected to Claims 3-7, 10, 11, 21 and 22 as being dependent upon a rejected base claim, and that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants submit that based upon the arguments below that Claim 1 is in a condition for allowance, thereby making Claims 3-7, 10, 11, 21 and 22 likewise allowable.

The Examiner has rejected Claims 1-2 under 35 USC 102(b) as being anticipated by Alanara, et al. (EP 448369A2). Applicants traverse these rejections. To anticipate a claim, a reference must teach each element of the claim. M.P.E.P. 2131. Applicants submit that Alanara, et al. does not anticipate Claims 1-11, 21 and 22 as it fails to teach each limitation recited in Claim 1 and included by dependency in Claims 2-11, 21 and 22, including the limitations of *“checking the identification code against a list stored locally at the card acceptance location, wherein the list is received from a second device; and if the identification code of the smart card is listed on the list, performing an action on the smart card”* (emphasis added).

In reading the Alanara, et al. patent, it becomes apparent that the intent of this patent is to prevent the fraudulent replacement of an authorized smartcard with an unauthorized smartcard during usage of a service (e.g. telephone call) for which an authorized smart card is required. In col. 3, lines 6-12 and 17-22, Alanara, et al. specifically states that this is the intent of the invention. The ID of the authorized card is stored into a memory device of the apparatus (“Reader”) so that during operation the ID of the inserted card (which may have replaced the authorized card) can be compared to the authorized ID stored in memory, to prevent fraudulent usage (col. 4, lines 20-36). Nowhere in Alanara, et al. is there a mention of a list of IDs, stored in the apparatus and received from a second device, against which the ID of the smartcard is compared, including in the language cited by the Examiner at col. 3, lines 16-35. The invention in Alanara, et al. only claims to check the ID of an inserted smart card against the ID of the currently authorized smartcard in operation and never makes claim or reference to a list of IDs.

Furthermore, Alanara, et al. never claims to perform an action on the smartcard if it is deemed to be a different smart card than the one authorized for the current usage, including in the language cited by the Examiner at col. 4, lines 6-41. Alanara, et al. does claim at col. 4, lines 29-33 that the apparatus will "...disconnect the current operation and connections of the apparatus." Alanara, et al. goes on to describe that the ID of the authorized card is erased from the card reader ("apparatus") in col. 4, line 36-40. However, nowhere in this cited patent is the smart card disabled/enabled or otherwise modified in any way. In summary, Alanara, et al. only teaches the disabling of the current service, not the card.

Based upon all of the above reasons, Applicants submit that Alanara, et al. does not anticipate Claim 1 and that this claim is, therefore, in a condition for allowance. Applicants further submit that Claims 2-11, 21 and 22, which depend from and include all of the limitations of Claim 1 are likewise in a condition for allowance for all of the reasons above associated with Claim 1.

The Examiner has rejected Claims 8-9 under 35 USC 103(a) as being unpatentable over Alanara, et al. in view of Freeman (USPN 6,068,183). Applicants traverse these rejections. To establish a *prima facie* case of obviousness under 35 U.S.C. §103 based upon the combined teachings of two or more references, three criteria must be met. First there must be some suggestion or motivation to combine the reference teachings. Second there must be a reasonable expectation of success, and finally, the references when combined must teach or suggest all of the claim limitations. *See* M.P.E.P. §2143. Applicants respectfully submit that the combined teachings of Alanara, et al. and Freeman do not render pending Claim 8 and 9 obvious because the combined teachings fail to teach all of the claim limitations.

More specifically, as argued above the limitations recited in Claim 1 of "*checking the identification code against a list stored locally at the card acceptance location, wherein the list is received from a second device; and if the identification code of the smart card is listed on the list, performing an action on the smart card*" (emphasis added) are not taught in Alanara, et al.. Moreover, the Examiner has conceded in a prior paper (Paper No. 4, page 3) that Freeman does not teach these limitations. Therefore, Applicants believe that for these additional reasons, Claims 8 and 9 are in a condition for allowance.

The Applicants note the art cited, but not relied upon by the Examiner.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have argued herein that such amendment was made to distinguish over a particular reference or combination of references.

The Applicants believe that the subject application is in condition for allowance. Such action is earnestly solicited by the Applicants.

In the event that the Examiner deems the present application non-allowable, it is requested that the Examiner telephone the Applicants' attorney or agent at the number indicated below so that the prosecution of the present case may be advanced by the clarification of any continuing rejection.

Accordingly, this application is believed to be in proper form for allowance and an early notice of allowance is respectfully requested.

Please charge any fees associated herewith, including extension of time fees, to Deposit Account No. 502117.

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Respectfully submitted,

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